

REMARKS

Applicant thanks the Examiner for the very thorough consideration given the present application. Claims 25, 28, 30-34, 50, and 55 remain in the application and claim 25 is independent.

The present amendment cancels claims 9, 19, 48, and 53 without prejudice or disclaimer. Claims 1-8, 10-18, 20-27, 29, 35-47, 49, 51, 52, and 54 were previously canceled without prejudice or disclaimer. Accordingly, it is respectfully submitted that this Amendment should be entered.

Objection of Claim 9

Item 3 on page 2 of the outstanding Action objected to the word “chromacities” in claim 9. As claim 9 has been canceled this objection is clearly moot.

Rejection of Claims 9, 19, 48 and 53

Item 5 on pages 2-10 of the outstanding Action presents a rejection of claims 9, 19, 48, and 53 under 35 U.S.C. § 103(a) as unpatentable over Nishikawa et al. (U.S. Patent 5,296,945, hereinafter Nishikawa), in view of Belucci et al. (U.S. Patent 5,913,542, hereinafter Belucci), Yamamoto et al. (JP 06-123197, hereinafter Yamamoto), Sakamoto (U.S. Patent 6,333,993), and further in view of the new reference to Jaspers (U.S. Patent 5,208,661).

The rejection of claim 9, 19, 48 and 53 is moot as these claims have been canceled as noted above.

Rejection of Claims 25, 27, 28, 50, and 55

Item 6 on pages 10-18 of the outstanding Action present a rejection of claims 25, 27, 28, 50, and 55 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Belucci, Yamamoto, and Sakamoto in further view of newly cited Hata (US 6,067,377).

It is first noted that claim 27 was canceled by the Amendment filed April 24, 2008. Accordingly, the rejection of a canceled claim 27 is clearly moot.

Except for the newly cited reference to Hata, this prior art applied to pending claims 25, 28, 50 and 55 has been discussed throughout the protracted prosecution of this application and the comments made as to the deficiencies of the previous combination of Belucci, Yamamoto, and Sakamoto are incorporated herein in addition to the traverse based upon the added Hata reference that is presented below.

The paragraph bridging pages 10 and 11 of the outstanding Action admits that the combined teachings of Belucci, Yamamoto, and Sakamoto fail to teach the base independent claim 25 requirement that the step of separating the image into the plurality of areas comprises “comparing properties of adjoining pixels of the image; and determining that two adjoining pixels belong in the same area if the compared properties of the two adjoining pixels are less than predetermined thresholds for each property compared.” Accordingly, the outstanding Action turns to Hata to cure this deficiency of Belucci, Yamamoto, and Sakamoto.

However, what Hata actually teaches is a method of determining background pixels and non-background pixels that includes detecting pixel data of eight pixels surrounding an object pixel as noted at col. 9, lines 1-5, and then determining whether each pixel is a background or a non-background pixel “by comparing the pixel with a slash hold value,” as noted at col. 9, lines 6-8. If a background pixel is determined to be present based on this slash hold value comparison, col. 9 lines 16-18 of Hata teach that the number of pixels that the object pixel is away from the non-background pixel is determined by “counting pixels from a non-background pixel located in a boundary contacting the background pixel to the object pixel in a step S23.” A correction coefficient (t1, t2 or t3) is then selected based on the counted number P in a step S24 as taught at col. 9, lines 18-20. A specific example is then set forth at col. 9, lines 21-62, while col. 9, line 63-col. 10, line 2 present a time advantage as to this “second embodiment” that was discussed beginning at col. 8, line 33.

Clearly, nothing presented by Hata at any of the relied upon portions of col. 1, lines 56-64, col. 8, lines 33-67, or col. 9, line 1-col. 10, line 2 teaches what is asserted to be taught in the outstanding Action in terms of “comparing the pixels to adjacent pixels to determine whether a pixel belongs to a background area” because the taught comparison is that of “comparing the pixel with a slash hold value,” not with another pixel. Also nothing in Hata even remotely

suggests the above-noted claim 25 requirement for “comparing properties of adjoining pixels of the image; and determining that two adjoining pixels belong in the same area if the compared properties of the two adjoining pixels are less than predetermined thresholds for each property compared,” contrary to the completely unexplained conclusion at page 17, lines 16-19.

Such reliance on completely subjective conclusions is contrary to established case law requiring the PTO to present factual evidence, not assumptions or subjective conclusions. *See In re Zurko*, 258 F.3d 1379, 1386, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001) (“With respect to core factual findings in a determination of patentability, however, the [PTO] . . . must point to some concrete evidence in the record in support of these findings.”); *In re Lee*, 277 F.3d at 1343-44, 61 USPQ2d at 1434 (This factual question . . . material to patentability [cannot] be resolved on subjective belief and unknown authority.”); and *In re Warner*, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967) (“The Patent Office has the initial duty of supplying the factual basis for its rejection. It may not . . . resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in its factual basis.”).

Accordingly, as the rejection of independent claim 25, and pending claims 28, 50, and 55 that depend from claim 25, under 35 U.S.C. § 103(a) as unpatentable over Belucci, Yamamoto, and Sakamoto, in view of Hata is in error for at least the reasons noted above, the withdrawal of this rejection is respectfully requested.

Rejection of Claims 30 and 31

Item 7 on pages 18-20 of the outstanding Action present a rejection of claims 30 and 31 as being unpatentable over Belucci, Yamamoto, Sakamoto, and Hata in further view of Daly et al. (US 6, 173,069, hereinafter Daly).

Daly is cited as to the subject matter added by claims 30 and 31 and does not cure the deficiency noted above as to the reliance on Belucci, Yamamoto, Sakamoto, and Hata. Accordingly, claims 30 and 31 patentably define over the applied references for at least the same reason that parent independent claim 25 does and withdrawal of this improper rejection of claims

30 and 31 under 35 U.S.C. §103(a) as being allegedly unpatentable over Belucci, Yamamoto, Sakamoto, and Hata in further view of Daly is respectfully requested.

Rejection of Claim 32

Item 8 on pages 20-21 of the outstanding Action present a rejection of claim 32 as allegedly being unpatentable over Belucci, Yamamoto, Sakamoto, and Hata in further view of O'Brill et al. (US 5, 937,081, hereinafter O'Brill).

O'Brill is cited as to the subject matter added by claim 32 and does not cure the deficiency noted above as to the reliance on Belucci, Yamamoto, Sakamoto, and Hata. Accordingly, claim 32 patentably define over the applied references for at least the same reason that parent independent claim 25 does and withdrawal of this improper rejection of claim 32 under 35 U.S.C. §103(a) as being allegedly unpatentable over Belucci, Yamamoto, Sakamoto, and Hata in further view of O'Brill is respectfully requested.

Rejection of Claim 33

Item 9 on pages 21-22 of the outstanding Action present a rejection of claim 33 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Belucci, Yamamoto, Sakamoto, Hata, and O'Brill in further view of Fujimoto et al. (US 6,035,074, hereinafter Fujimoto).

Fujimoto is cited as to the subject matter added by claim 33 and does not cure the deficiency noted above as to the reliance on Belucci, Yamamoto, Sakamoto, Hata and O'Brill. Accordingly, claim 33 patentably define over the applied references for at least the same reason that parent independent claim 25 does and withdrawal of this improper rejection of claim 33 under 35 U.S.C. §103(a) as being allegedly unpatentable over Belucci, Yamamoto, Sakamoto, Hata, and O'Brill in further view of Fujimoto is respectfully requested.

Rejection of Claim 34

Item 10 on pages 23-24 of the outstanding Action present a rejection of claim under 35 U.S.C. § 103(a) as allegedly being unpatentable over Belucci, Yamamoto, Sakamoto, Hata , O'Brill , and Fujimoto in further view of Nishikawa.

Nishikawa is cited as to the subject matter added by claim 34 and does not cure the deficiency noted above as to the reliance on Belucci, Yamamoto, Sakamoto, Hata, O'Brill, and Fujimoto. Accordingly, claim 34 patentably define over the applied references for at least the same reason that parent independent claim 25 does and withdrawal of this improper rejection of claim 34 under 35 U.S.C. §103(a) as being allegedly unpatentable over Belucci, Yamamoto, Sakamoto, Hata, O'Brill, and Fujimoto in further view of Nishikawa is respectfully requested.

CONCLUSION

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Raymond F. Cardillo, Reg. No. 40,440 at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.14; particularly, extension of time fees.

Dated: September 24, 2008

Respectfully submitted,

By

D. Richard Anderson

Registration No.: 40,439

BIRCH, STEWART, KOLASCH & BIRCH, LLP

8110 Gatehouse Road

Suite 100 East

P.O. Box 747

Falls Church, Virginia 22040-0747

(703) 205-8000

Attorney for Applicant